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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,012	12/02/2003	Peter C.R. Emtage	NUVO-02CP	5966

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NUVELO, INC
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EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT	PAPER NUMBER
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1643

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,012

Applicant(s)

EMTAGE ET AL.

Examiner

Sheela J. Huff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 26, drawn to polynucleotides SEQ ID NO. 1 and 2, vectors, host cells and methods of making polypeptides using host cells, classified in class 536, subclass 23.1.
- II. Claims 11-14, drawn to polypeptide and composition, classified in class 530, subclass 350.
- III. Claims 15-19, drawn to antibody, classified in class 530, subclass 387.1+.
- IV. Claim 20, drawn to method of detecting polynucleotide by detecting complex, classified in class 435, subclass 6+.
- V. Claims 21-22, drawn to method of detecting polynucleotide using hybridization/amplification, classified in class 435, subclass 6.
- VI. Claim 23, drawn to method of detecting polypeptide, classified in class 435, subclass 7.23+.
- VII. Claim 24, drawn to method of identifying a compound that binds to polypeptide by detecting complex formation, classified in class 435, subclass 6+.
- VIII. Claim 25, drawn to method of identifying a compound by detecting reporter gene expression, classified in class 435, subclass 6.

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- IX. Claims 27-31, 33 93-41(as they read on claim 33) and 46, drawn to method of killing of inhibiting growth of KIRHy1 and composition, classified in class 424, subclass 131.1+.
- X. Claims 32, 39-41(as they read on claim 32), drawn to method of targeting KIRHy1 protein on cells using antibody, classified in class 435, subclass 7.91.
- XI. Claim 34, 37, 39 and 41 (as they read on 34 and 37) and 50-51, drawn to method of killing or inhibiting the growth of KIRHy1 cells using compound/small molecule, classified in class 514, subclass 19+.
- XII. Claim 35-36, 39 and 41 (as they read on 35-36) and 48-49, drawn to method of killing or inhibiting the growth of KIRHy1 cells using nucleic acid, classified in class 514, subclass 44.
- XIII. Claim 38, 39 and 41 (as they read on 38), drawn to method of killing or inhibiting the growth of KIRHy1 cells using a polypeptide, classified in class 514, subclass 12.
- XIV. Claims 42-44, drawn to method diagnosing cancer suing mRNA, classified in class 435, subclass 6.
- XV. Claims 42-43 and 45, drawn to method of diagnosing cancer using antibody, classified in class 435, subclass 7.23+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or

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they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are chemically and structurally different, have different modes of operation and can be used in materially different processes. For example, the polynucleotides of Group I can be used in hybridization assays, whereas the products of Groups II-III cannot. The protein of Group II can be used to make antibodies and in therapy, whereas the compounds of Groups I and III cannot. The antibodies of Group III can be used in immunoassays, affinity purification etc, whereas the compounds of Groups II and III cannot.

Inventions IV-XV are unrelated because they involve different processes and have different effects. For example, the method of Inventions [IV-V], [VII-VIII], [IX and XI-XIII] and [XIV and XV] are all directed to different methods using different reagents and having different end results, such as a detection, diagnosis, killing or targeting. Furthermore, between Inventions IV and V they each involve different processes and reagents and a search of one would not entail a search of the other. Similar distinctions are found between inventions [VII-VIII], [IX and XI-XIII] and [XIV and XV]

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Due to the complexity of this restriction, a telephone call was not made to request an oral election to the above restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Oath/Declaration


The declaration filed 10/22/04 contains a typo. The declaration indicates that the amendment was filed 10/26/04. This should clearly be 10/22/04 because the amendment was filed with the declaration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Tuesdays and Thursdays from 5:30am to 2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sheela J Huff
Primary Examiner
Art Unit 1643

sjh